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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/040,319 | 01/02/2002 | Cyrus Kephra Becker | R0079C-REG | 3043 |

24372 7590 04/04/2003

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3401 HILLVIEW AVENUE
INTELLECTUAL PROPERTY LAW DEPT., MS A2-250
PALO ALTO, CA 94304-9819

EXAMINER

TRUONG, TAMTHOM NGO

| | |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1624

DATE MAILED: 04/04/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/040,319

Applicant(s)

BECKER ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 17, 25, 28 and 32-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-24, 26, 27, 30 and 31 is/are rejected.
- 7) ☒ Claim(s) 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's election with traverse of group I, drawn to compounds of formula I wherein Z is $-C(=O)-$. The traversal is on the ground that there is no burden of searching. This is not found persuasive because the two groups need separate on-line searches. Furthermore, a reference which reads on group I does not necessarily read on group II (as evident by GB 1,062,357 – cited by applicants).

It is noted that Group I includes claims that are drawn to compounds of Group II, and claims of method of treatment as well as process of making. Thus, group I is now further restricted and revised as follows:

Ia. Claims 1-16, 18-24, 26, 27, 29-31 (part of each), drawn to compounds of formula I with Z as $-C(=O)-$, and pharmaceutical compositions thereof, classified in class 544, subclasses 279, 284, 350, etc.

Ib. Claims 32-39 (part of each) drawn to process of making compounds of formula (I) with Z as $-C(=O)-$, and method of treatment using said compounds, classified in class 514, subclasses 249, 264.1, 266.2, 266.21, etc.

Inventions of Group Ia and Ib are related as product and process of use and making. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the compounds in group Ia can have a different method of treatment, and can be prepared by a different process (as evident by GB 1,062,357).

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During a telephone conversation with Ms. Anastasia Winslow on 3-27-03 a provisional election was made with traverse to prosecute the invention of Group Ia, claims 1-16, 18-24, 26, 27, 29-31 (part of each). Affirmation of this election must be made by applicant in replying to this Office action. Claims 17, 25, 28 and 32-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

1. The disclosure is objected to because of the following informalities: The generic structure of formula I shows a single bond between X and Y (when they are carbons). However, species have double bond between X and Y (when they are carbons). Such inconsistency creates confusion.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-16, 18-24, 26, 27, 30, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

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- a. In the structure of formula I, it appears that there is a single bond between X and Y when both are carbons. If that the case, both X and Y will have incomplete valences. The specification, however, shows species having a double bond between X and Y when they are carbons. Thus, from the structure of formula I, it is confusing whether or not a double bond will always be between X and Y when they are both carbons.
- b. Claim 10 lacks antecedent basis because it recites "haloalkyl" as a substituent on a ring formed by R^2 and R^3 . Said limitation is not recited in claim 9 or (ultimately) in claim 1. Also, claim 10 recites the limitation of "lower alkyl" twice.

Claim Objections

3. Claim 29 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Said claim recites species that are not taught or suggested by the prior arts of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (9:30-5:00) & every other weekend (fom 3-15).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Tamthom N. Truong
Examiner
Art Unit 1624

April 3, 2003